

DOCKET NO: 4544-011-25 DIV

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: :
MICHAEL D. QUINN ET AL. : GROUP ART UNIT: 3311
SERIAL NO: 08/420,503 :
FILED: APRIL 12, 1995 : EXAMINER: NASSEF
FOR: THERMODILUTION CATHETER HAVING
A SAFE, FLEXIBLE HEATING ELEMENT

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REQUEST FOR RECONSIDERATION OF THE
DENIAL OF THE 37 CFR 1.607 REQUEST
FOR AN INTERFERENCE

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20031

SIR:

Responsive to the office action dated September 04, 1996,
please consider the following:

REMARKS

The office action states:

The examiner acknowledges applicant's request under 37 C.F.R. §1.607 to provoke an interference with U.S. patent number 5,435,308 to Gallup et al. However, all of the independent claims of the patent recite a pressure port located between the heating element and the distal end of the catheter. Applicant cannot make this claim. Applicant has now amended the claim to recite a port. However, no location of the port has been recited. The examiner notes that during prosecution of the Gallup et al patent, claims 1-6 were rejected over Moran (4,776,340) in view of Kalil (4,217,910), while claim 7, which was the location of the pressure port between the distal end of the catheter and the heating element, was indicated to defined [sic; define] over the art. The examiner further notes that Moran, the base reference, had a port. Therefore, the location of the port was the patentable feature. Accordingly, it is the examiner's conclusion that the claims of the Gallup et al patent, which define the location of the port,

are patentably distinct, as defined by 37 C.F.R. §1.601, from the present claims. Accordingly, the interference has not been set up by the examiner.¹

However, the rationale for denying the 37 CFR 1.607 request is inconsistent with the following statement in the office action regarding the Willis et al. patent and the Khalil '910 patent:

Willis et al shows all of the features of the claims except that it measures cardiac output using a cold bolus injection. Khalil teaches that cold bolus injections and using external heaters [to] heat the blood are equivalent methods of measuring cardiac output (see background section). Accordingly, it would have been obvious to modify Willis et al to use a heating coil, rather than a cold bolus injection, as it is merely the substitution of one known equivalent measurement technique for another.²

The denial of the 37 CFR 1.607 request is inconsistent with the assertion that the combinational structure would have been obvious. This is so, because the combinational structure does have a thermal pressure port which is distal the heating coil. That is, replacing the cold bolus injection port P' shown in figure 1 in Willis et al. with a heating coil results in a cardiovascular catheter system having the port P/M' that is as shown in Figure 1 in Willis et al. -- i.e., the port P/M' is distal the resistive heater, and Willis et al. states that the port P/M':

¹Office action page 2 lines 1-20.

²Office action page 5 lines 8-16.

can be left unobstructed, for measurement of pressure in the right ventricle through a fluid column in the lumen....³

Thus, in the very small subset of the cardiovascular catheter art that defines the multilumen catheter art, it was well known to provide a port for measuring pressure and locating the port for measuring pressure distal the location where heat was injected into the blood. Therefore, the conclusion in the office action that the claims of the Gallup et al. patent are patentably distinct from the claims in the present application because, in the claims in the Gallup et al. patent, "the location of the port was the patentable feature"⁴ is controverted by the location of a port for providing exactly the same function in Willis et al. and the admission in the office action that it would have been obvious to modify the catheter disclosed in Willis et al. to include a heating element instead of the bolus injection port P'.

The only other difference between the combinational structure (of the Willis et al. patent and the Khalil '910 patent) and the subject matter defined by claim 1 of the Gallup et al. patent is the recitation of "a necked down portion" of the catheter. However, the subject matter defined by claim 45 of this application has a necked down portion of the catheter. Thus, the inescapable conclusion is that the subject matter defined by claim 1 in the Gallup et al. patent would have been obvious in view of the subject matter defined

³Willis et al. column 7 lines 6-8; emphasis supplied.

⁴Office action page 2 lines 14-15.

by claim 45 in this application, the Willis et al. patent, and the Khalil '910 patent.

It is submitted that, for the reasons set forth below, the subject matter defined by the claims in this application and in the Gallup et al. patent satisfies the requirements for an interference.

First, this application contains at least one allowable claim (which the applicants have not argued should not be designated as not corresponding to the proposed count of the proposed interference).

Second, for the reasons presented above, the feature recited by the claims in the Gallup et al. patent which the office action relies upon as patentably distinguishing the claims in the Gallup et al. patent from the present claims (i.e., the "distal thermal pressure port"), the office action also asserts does not do so. Therefore, the office action sub silentio admits that the subject matter defined by (at least one of) the claims in the Gallup et al. patent would have been obvious in view of the subject matter defined by (at least one of) the claims in the present application and the prior art available against the Gallup et al. patent. 37 CFR 1.601(n).

For the foregoing reasons, it is respectfully submitted that the denial of applicants' 37 CFR 1.607 request was improper. Therefore, applicants respectfully request that the examiner fill in the initial interference memorandum and forward this application to the Board of Patent Appeals and

Interferences for declaration of the interference.

Respectfully submitted,



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